REMARKS – General

1. Re Examiner's response [1], the Applicant duly notes response.

2. Re Examiner's response [2], the Applicant duly notes response.

3. Re Examiner's response [3], the Applicant duly notes response and is most grateful for the information that the Examiner has shared with the Applicant.

Re Examiner's Response To Arguments

4. Re Examiner's response [4], the Applicant duly notes response.

5. Re Examiner's response [5], the Applicant duly notes response.

6. Re Examiner's response [6], the claims of record have been modified to overcome the rejection under 35 U.S.C. 112 2nd paragraph.

7. Re Examiner's response [7], Claims 14 and 36 have been modified to overcome the rejection.

8. Re Examiner's response [8], the Applicant sets forth that the use of the trademark BLUETOOTH is commonly used in issued US PTO patents. Usage is not only in the Specification and the Abstract, but also in the Claims of the issued patents, often without reference to any trademarks and is clearly used as an accepted term for a commonly known and used technology standard.

A search by the Applicant using the term BLUETOOTH was done against the US PTO's "Issued Patents" database ("`ACLM/bluetooth`"), which returned 1,062 patents (on Oct. 18, 2007) that currently use the term BLUETOOTH in each of the listed patents' Claims section.

Applicant respectfully submits that the technology term BLUETOOTH is similarly accepted and used today by industry, etc. as the term "Ethernet" is used and accepted. Ethernet is a trademark of the Xerox Corp. and is currently used in 2,646 US PTO patents' Claims sections (on October 18, 2007).

Based on these precedents, Applicant respectfully requests that the Examiner reconsiders the rejection of Claims **16** and **38** as "**rendered indefinite by the use of the trademark term BLUETOOTH**".

The Novel Features Of The Claims Provide New and Unexpected Results And Hence Should Be Considered Unobvious, Making The Claims Patentable Under Sec. 103

9. The cited and relied upon reference of Ruppert et al. discloses a system whereby a shopper primarily uses a previously created "*universal*" (col. 5 lines 6-20) shopping list in the PERSONAL SCANNER™ (see abstract: "*The user selects a shopping list from a collection... or by spelling out the items to purchase on a keyboard*"; (see col. 4, lines 28-47; col. 4, lines 63-66; col. 5 lines 5-20; col. 5 lines 29-40; col. 6 lines 58-66).

Ruppert's PERSONAL SCANNER™ is then taken to a store and it is used to check off products picked off the shelves against the selected shopping list, by scanning in their barcodes (see col. 5, lines 34-40).

Ruppert et al. also teaches a method whereby the shopper can add scanned items that were not previously stored in the PERSONAL SCANNER™ shopping list, but this is done only when the shopper is physically in the store (see col. 6, lines 49-55).

The Applicant's invention teaches the primary use of scanned, or manually entered product barcodes, without entering a store, to create shopping lists. This method eliminates the need to use complex logic (e.g. using "*fuzzy logic*" as described in Ruppert et. al.) to match a user's selections with those of the store's definitions (see col. 15, lines

24-65).

Furthermore, both Ruppert et al. and Petrovich do not teach the capture and use of the date and time on which an item was added to a shopping list via the portable barcode scanner. Applicant's invention teaches the use of this timestamp data to predict when a regularly needed consumer's item should be acquired. Neither Ruppert el al. nor Petrovich teach this method of using a timestamp to (a) determine frequently used products and (b) to provide the consumer with a predictive reminder of regularly used products that the consumer may be unaware of his need for, at the time of compiling a shopping list. Applicant teaches this method being executed by a consumer's first computer, which is resident in the consumer's abode.

10. Re The Examiner's Response Referencing Objections By Page Number in the Office Action:

(i) Page (4), reference "**As per claim 14, Ruppert a method for creating a consumer's shopping list prior to entering a store**", Applicant respectfully submits that Ruppert does not teach the consumer's creation of a shopping list prior to entering a store by the consumer scanning needed products' UPC barcodes, as does the Applicant's invention. Ruppert et al. teach modifying pre-stored shopping lists (col. 4 lines 64-68; col. 5 lines 1-33; col. 6 lines 60-66), as well as modifying the pre-stored shopping list whilst in-store (col. 6 lines 49-55). To emphasize the use of pre-existing lists, Ruppert et al. teach an embodiment, i.e. a "*model*" (col. 5 line 32) as described by Ruppert et al., which incorporates only a single, pre-stored shopping list for the consumer (col. 5 lines 26-33).

Furthermore, Ruppert et al. teach an apparatus to be used in-store (Abstract, lines 58-102; Fig. 5; Fig. 7; Fig. 11; col. 2 lines 10-25; col. 2 lines 35-38; col. 2 lines 47-50; col. 3 lines 2-4; col. 3 lines 26-30; col. 4 lines 33-35; col. 5 lines 34-40; col. 5 lines 62-68; col. 6 lines 1-18l col. 6 lines 27-38; col. 6 lines 49-55; col. 8 lines 1-5; col. 8 lines 63-66; col. 9 lines 1-68; col. 10 lines 25-30; col. 10 lines 43-68; col. 11 lines 11-26; col. 12

lines 20-68; col. 13 lines19-25l col. 15 lines 14-16). Ruppert et al. do not teach the use of incorporating a UPC barcode scanner to shop with online, as does the Applicant's invention, with shopping list items either shipped by the online store, or packed for later pickup by the consumer at the store.

(ii) Page (4), Examiner's reference (a) is duly noted and the Applicant's Claim 14 and Claim 36 have been amended to overcome this objection.

Applicant would respectfully like to point out that Ruppert does not teach the use of a barcode scanner connecting to a consumer's computer and network, i.e. connecting to "a consumer's first computer" via "a first network infrastructure" as claimed by the Applicant. Examiner's reference "**(see col. 8 lines 50-53)**" teaches downloading "*the store's current price list by dialing the store computer*" to the scanner, and not to the consumer's first computer. This cited reference does not teach the Applicant's method of using a scanner with "using one or more said consumer's first computers comprising the sub-steps of;

> (i) receiving data from, and transmitting data to, said portable barcode scanner over said consumer's first network infrastructure ...
> (ix) indicating that said transmitted and said received data to and from said portable barcode scanner has been successfully sent and received".

In the Examiner's reference, Ruppert does not teach that data has been successfully downloaded to the scanner, or from the scanner. Furthermore, in this cited reference, Ruppert et al. do not teach downloading data from the barcode scanner to a consumer's computer. This cited reference teaches downloading data in one direction only from the store computer to the PERSONAL SCANNER™, i.e. "... *downloading the store's current price list by dialing the store computer*" (col. 8 lines 52-53). This is not what is claimed by the Applicant and would not achieve what the Applicant claims.

(iii) Page (5) under item (a), Examiner's references "**(fig. 1 block 24)**" and "**see at least fig. 1 block 24, abstract, coupons are matched and discounted**" do not teach the storing of the date and time of the scanned item's event as the Applicant teaches. This is important because without this information the predictive means that the Applicant's invention teaches would not be possible, i.e. the frequency with which products are repeatedly needed and purchased [Applicant's Claim 14 (c)(v), Claim 14 (c)(viii), Claim 36 (c)(v) and Claim 36 (c)(viii)]. The Applicant respectfully asserts that the use of this timestamp is not commonly known in the art, because if it had been, the Applicant respectfully asserts that both of the Examiner's cited references would have noted this timestamp use.

Both references cite other commonly known art, e.g. Petrovich cites various types of the commonly known Ethernet standards (para' [0134)] and in Ruppert the functioning of a barcode scanner (col. 9, lines 7-50).

(iv) Page (5) under item (b), Examiner's reference "**(see col. 8 lines 50-53)**", Ruppert teaches the downloading of the "*store's current price list*" to the scanner from the store computer, whilst the Applicant's claim refers to a scanner using "using one or more said consumer's first computers comprising the sub-steps of;

> (i) receiving data from, and transmitting data to, said portable barcode scanner over said consumer's first network infrastructure...
>
> (ix) indicating that said transmitted and said received data to and from said portable barcode scanner has been successfully sent and received",

i.e. providing user feedback that data has been electronically transmitted from the scanner to a consumer's computer and not to the scanner from a store computer as taught in the Examiner's reference "**(see col. 8 lines 50-53)**". Furthermore, the Examiner's cited reference does not teach any indication that data has been successfully transferred.

(v) Page (6), Examiner's reference under item (b) "**(see col. 2 lines 43-53)**", Ruppert teaches the downloading of product coupons associated with a store's price list. This reference does not teach a "consumer's first computer" "(iv) tracking frequency that said product barcode has been received from said portable barcode scanner over said first network infrastructure; (v) providing a specific notification of repetitive scanned said product barcodes without repetitively needing a continuously scanned entry of said product barcodes, said continuously scanned entry occurring at varying times", as does the Applicant's invention. As mentioned previously this is important, because without this methodology the predictive means that the Applicant's invention teaches would not be possible, i.e. the frequency with which products are repeatedly purchased, thereby predicting when the consumer will most probably run out of the product, and hence notifying the consumer of this predicament and automatically adding these "forgotten" products to the shopping list, without the consumer's intervention [Applicant's Claim 14 (c)(v), Claim 14 (c)(viii), Claim 36 (c)(v) and Claim 36 (c)(viii)].

(vii) Page (6), Examiner's reference under item (c) is duly noted by the Applicant.

(viii) Page (6), Examiner's reference under item (d) "**(see col. 6 lines 1-18)**", Ruppert teaches the downloading of the physically entered store's current price list to the scanner from the store computer. This reference does not teach a scanner "transferring said scanned product barcode or said product coupon barcode to said consumer's first computer, over said first network infrastructure", i.e. in the Examiner's reference Ruppert et al. do not teach the transferring of data from the scanner to a consumer's computer as claimed by the Applicant. Examiner's reference teaches the downloading of price list data (col. 6 line 2; col. 6 line 12; col. 6 lines 16-17) from the physically entered (col. 6 lines 6-7; col. 6 lines 11-12) store's computer to the scanner, i.e. in the opposite direction,

as well as to a non-store computer, as claimed by the Applicant and hence would not achieve what the Applicant claims.

(ix) Page (6), Examiner's references " under item (e) **(col. 7 lines 13-20, fig. 6 111)**", in the first Examiner's reference, i.e. "**(col. 7 lines 13-20)**" Ruppert et al. teach making changes to a shopping list, which are then "*spelled out by the user by selection of letters and/or numbers*" (col. 7 lines 14-15). Examiner's second reference, i.e. "**fig. 6 111**" is a flowchart question-block titled "*STORE IN DATABASE*". This Block 111 is part of a flowchart in Ruppert et al. Fig. 6 that deals with the process to "*RETRIEVE STORE PRICE LIST AND SET BUDGET*" in the Ruppert scanner device and not on a "consumer's first computer" as claimed by the Applicant. Furthermore neither of the Examiner's references mentions the capture of the "... date and time on which said product barcode was scanned.." as claimed by the Applicant. As mentioned previously this is important, because without this information the predictive means and automatic adding of items to a shopping list, that the Applicant's invention teaches would not be possible [Applicant's Claim 14 (c)(v), Claim 14 (c)(viii), Claim 36 (c)(v) and Claim 36 (c)(viii)], i.e. the frequency with which products are repeatedly purchased is not taught in either of the Examiner's relied upon references.

(x) Pages (6-7), Examiner's reference under item (f) "**(see col. 12 lines 23-26,)**" teaches the use of a magnetic strip to prevent "*shoppers from putting things in their carts which have not been scanned*" (col. 12 lines 20-21) as is commonly known in the art. Although not clearly stated in Ruppert, it can be assumed that the security magnetic strip is placed on each purchasable item in the store. This is commonly known and old in the art. Ruppert et al. do mention that "*other information such as unit price, etc. may be printed*" (col. 12 lines 25-26), but this form of "printing" is not what the Applicant claims. The Applicant is simply claiming the printing out of the shopping list on a standard PC printer, e.g. an HP LaserJet, etc. Applicant respectfully claims that a magnetic strip on an individual product in no way compares with printing out a complete shopping list containing multiple products on a standard PC printer. Reading a list on a

magnetic strip is limited not only physically (i.e. to storing only the *specific* product's data, as is commonly known in the art, and not a complete multi-product shopping list), but needs special equipment as well to read the "printed" magnetic strip's data, whereas a printed-paper list requires only human sight, or touch if printed for the visually impaired.

(xi) Page (7), Examiner's reference under item (g) "**(col. 6 lines 1-19,)**" teaches the downloading of a store's "*price list*" (col. 6, lines 1-3; col. 6, lines 5-7; col. 6, line 12-23; col. 6, lines 15-16) to Ruppert's scanner from the store's computer upon physical entry to the store. Applicant is claiming sending, i.e. electronically transmitting the shopping list from a "consumer's first computer" and not from the scanner, to an online store via a network; the store's staff then gathers the products on the electronically sent shopping list and then ships (e.g. via FedEx or UPS) the products to the consumer thereby fulfilling the placed order. Applicant respectfully claims that the Examiner's reference does not teach what the Applicant has claimed.

(xii) Page (7), Examiner's references under item (h) "**(col. 6 lines 1-19,)**" teaches the downloading of a store's price list (col. 6, lines 1-3; col. 6, lines 5-7; col. 6, line 12-23; col. 6, lines 15-16) to Ruppert's scanner from the store's computer upon physically entering to the store. Applicant is claiming sending, i.e. electronically transmitting the shopping list from a "consumer's first computer" and not from the scanner, to an online store via a network; the store's staff then gathers of the products on the sent shopping list and holds the products for the consumer to pick up later. Applicant respectfully claims that the Examiner's reference does not teach what the Applicant has claimed.

Applicant duly notes that Petrovich teaches that the user can shop electronically from home. Petrovich does not teach the printing of the user's shopping list at home. Petrovich does teach the printing of the shopping list in a "*shopping establishment*" via the kiosk cradle (Fig. 6 label 96; para' [0078]), or at the checkout (para' [0107]). Note that the kiosk cradle, and the checkout terminal must be connected to the host computer of the "*shopping establishment*", which provides the details associated with the barcodes

stored in Petrovich's "*portable terminal*" (Fig. 1, labels 16 and 96; para' [0016]; para' [0078; para' [0093]; para' [0097]; para' [0105]; para' [0107]).

(xiii) Page (8), Examiner's references under item (h), Examiner's "…. **Official Notice that the time and date of when the barcode was scanned is well known and old in the art at the time of invention**….", Applicant respectfully contends that the Applicant's use of the scanned / entered product's barcode's timestamp is not "**well known and old at the time of the invention**".

Applicant uses the timestamp as critical data to predict when a consumer's regularly, i.e. repeatedly needed product should be listed in his shopping list, even though the product has not been scanned or entered at the time that the current shopping list was compiled. Neither Ruppert, nor Petrovich mentions timestamps in their respective Specifications. Furthermore, neither of the relied upon references mention the specific use of a timestamp as claimed by the Applicant.

Applicant respectfully contends that the Applicant's use of the timestamp is not "**well known and old in the art at the time of invention**". Applicant thereby respectfully challenges the Examiner's "**Official Notice that the time and date of when the barcode was scanned is well known and old in the art at the time of invention**" and requests evidence to support this claim (see 37 C.F.R. 1.104(c)(2), 37 C.F.R. 1.104(d)(2) and *Zurko, 258 F.3d at 1386, 59 USPQ2d at 1697*).

(xiv) Page (8), Examiner's references under item (h), Examiner's reference "**As per claim 15** …", in the Applicant's dependent claim the first network is between the portable barcode scanner and the consumer's first computer. In Ruppert the wireless link is between the barcode scanner and the store's computer upon entry of the store (col. 6 lines 1-18; col. 8 lines 23-43; col. 11 lines 18-25), i.e. not between the devices as claimed by the Applicant.

(xv) Page (8), Examiner's references under item (h), Examiner's reference "**As per claim 17** ...", in the Applicant's dependent claim the first network is between the portable barcode scanner and the consumer's first computer. In Ruppert the wired link is between the barcode scanner and the store's computer upon entry of the store (Fig. 5; col. 6 lines 1-5; col. 11 lines 11-18; col. 11 lines 54-61), i.e. not between the devices as claimed by the Applicant.

(xvi) Page (8), Examiner's references under item (h), Examiner's reference "**As per claim 18** ...", Ruppert's Specification does not teach the use of a USB or IEEE 1394 wired links as claimed in the Applicant's dependent claim.

(xvi) Page (8), Examiner's references under item (h), Examiner's reference "**As per claim 19** ...", Ruppert's Specification does not teach the use of a personal computer, or an Internet Appliance, or a cell phone as the consumer's first computer as claimed in the Applicant's dependent claim.

(xvii) Page (9), Examiner's references under item (h), Examiner's reference "**As per claim 34** ...", Ruppert's Specification does not teach the use of a personal digital assistant or a cell phone as the consumer's portable computer as claimed in the Applicant's dependent claim whereby the consumer's first computer in Applicant's Claim 14 and Claim 34 comprises the sub-step of "`transferring said stored shopping list to a consumer's portable computer device`".

(xviii) Page (9), Examiner's references under item (h), Examiner's reference "**As per claim 35** ...", Ruppert's Specification only teaches the list for groceries (Fig. 1; Fig. 14; col. 1 line 23; col. 3 lines 26-27; col. 5 line 35; col. 10 lines 43-45; col. 12 line 12) and real estate (Fig. 10; col. 3 line 6; col. 13 line 61; col. 14 lies 1-50) and not for shopping lists comprising beauty aids, books, clothing, computer hardware, computer software, computer supplies, drugs, footwear, gifts, health aids and music as claimed in the Applicant's dependent claim.

(xix) Page (9), Examiner's reference under item (h), "**As per claims 20 and 42 ...for receiving product identification data from a UPC ... (see col. 6, lines 49-55)**" teaches generating a list and not "**selected by a consumer for inquiry (see col. 6, lines 49-55)**". Furthermore, the Applicant could respectfully find no mention of UPC in Ruppert. It is commonly known in the art that not all barcodes are UPCs. UPC is one of many specific symbologies used by barcode scanners.

The Applicant's dependent claims 20 and 42 simply specify the use of the Internet as the Applicant's claimed second network infrastructure, which connects to the consumer's first computer in Claims 14 and 36 respectively. Ruppert does not teach this method.

Petrovich does teach Internet connectivity, but it is not clear from Petrovich's Specification that the user connects to the shopping establishment's host computer from home via the Internet (Fig. 1; Fig. 24;Fig. 25; Fig. 26; para' [0060]; para' [0114]; para' [0137]; para' [0141]). Petrovich clearly uses the Internet to connect the shopping establishment's stackable cradles to the host computer as one embodiment (para' [0060] and para [0141]). Specifically Petrovich para' [0141] teaches "*...the cradle takes the place of the ISP, forwarding IP packets received on the PPP connection to the Ethernet and via the Ethernet to the Internet, and vice versa. With such a link, the portable terminals then establish a TCP/IP connection with the host computer, and synchronization operations are performed over the link*".

Applicant respectfully requests further evidence that per the Examiner's claim that the "**use of the Internet is common in the art and it would have been obvious to one of ordinary skill at the time the invention was made to employ the Internet with the invention of Ruppert...**" (see *Lee, 277 F.3d at 1344-45, 61 USPQ2d at 1434-35 [Fed. Cir. 2002]; Zurko, 258 F.3d at 1386, 59 USPQ2d at 1697*).

(xx) Page (10), Examiner's reference under item (h), "**As per claim 16 and 38 ...**", given the correction of the reference in a telephone interview (02 October 2007)

with the Examiner, Applicant notes the corrected reference "**(at least col. 8 lines 53-66, col. 6 lines 1-35 etc..)**". Applicant's claims 16 and 38 are dependent claims on Applicant's Claim 14 and 36 respectively, and thereby the Applicant respectively asserts that the Examiner's objection is thus overcome.

(xxi) Page (10), Examiner's reference (11), Applicant respectfully asserts that the novel features of the Applicant's claims provide new and unexpected results and hence should be considered unobvious, making the claims patentable under sec. 103.

9. Specifically, by providing the consumer with a method to create a shopping list, without having necessarily to enter a store physically or modifying pre-stored lists in a scanner, by scanning a product UPC barcode into a system that yields a usable in-hand shopping list (i.e. in electronic or print format, printed off the consumer's computer). The consumer only needs to know how to scan in, or manually enter a needed product's UPC barcode. The collected barcodes of needed products are then downloaded to a consumer's computer (i.e. not from a store computer to the scanner), which then gathers all other related information about the bar-coded products via the Internet (and not necessarily from the specific store's computer), and stores the retrieved information in a shopping list database present on the consumer's computer.

The consumer can either print out or download to a portable electronic device such as a PDA the shopping list stored on the consumer's computer and physically go to a store to shop for the items. The shopping list is not necessarily stored on a shopping establishment's host computer as is taught in Petrovich. Optionally, a method is taught by the Applicant that enables the consumer to transmit electronically his shopping list to an online store, which either ships the products on the consumer's shipping list to him, or packs all of the products for later pick up by the consumer, i.e. in both of these methods without the consumer having to shop physically in-store for the products on his shopping list. This electronic shopping feature is similar to one taught by Petrovich, but not Ruppert. It is not clear from Petrovich whether or not the online shopping is via the

Internet, or whether it is simply via a dialup modem directly into the shopping establishment's computer.

An important and distinguishing method of the Applicant's invention is the systematic learning of the consumption habits of the consumer. Noting the date and time on which product barcodes are entered by the consumer and then tracking the frequency (i.e. consumption pattern) of the entered barcodes achieves this novel and unobvious method. This critical feature is executed on a consumer's computer. In other words, the Applicant's invention includes providing a predictive database of user scanned and/or manually entered products that the consumer regularly uses, and automatically adds these to the consumer's shopping list, even if the consumer next forgets to scan / enter the product. This unique and unobvious feature eliminates the need for the consumer to remember all of the items to add to his shopping list, i.e. Applicant's invention "knows" when the consumer needs a regularly acquired product.

10. Applicant submits that the above-recited novel features in the Applicant's independent claims, and hence in all claims, provides new and unexpected results and hence should be considered unobvious, making the claims patentable under Sec. 103.

Request For Constructive Assistance

The undersigned has made a diligent effort to amend the claims of this application so that they define a novel method, which is also submitted to render the claimed method unobvious because it produces new and unexpected results. If, for any reason the claims of this application are not believed to be in full condition for allowance, applicant respectfully requests the constructive assistance and suggestions of the Examiner in drafting one or more claims pursuant to **MPEP 707.07(j)**, or in making constructive suggestions pursuant to **MPEP 706.03(d)** in order that this application can be placed in allowance as soon as possible and without the need for further proceedings.

Very Respectfully,

Lester Sussman

Lester Sussman
Applicant Pro Se

Certificate of Mailing

I certify that this correspondence will be deposited with the United States Postal Service as first class mail with proper postage affixed in an envelope addressed to: "Commissioner for Patents, P.O. Box 1450, Alexandria, VA 21313-1450" on the date below.

Date: 2007, November 26 Lester Sussman, Applicant